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EXAMINER

TANG, KAREN C

ART UNIT	PAPER NUMBER
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2451

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/742,151	Applicant(s) CROMER ET AL.	
	Examiner KAREN C. TANG	Art Unit 2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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- This action is responsive to the amendment and remarks file on 12/14/09.
- Claims 1-8, and 10-19 are presented for further examination.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12/14/2009 have been fully considered but they are not persuasive.

Specification objection:

Applicant argues that the term is supported in the specification

Examiner disagrees.

It appears that “the computer readable media” and “the computer readable storage media” is two separate terms, and according to 37 CFR 1.75 (d)(1), the terminology as claimed need to contain an antecedent support in the specification.

35 U.S.C 101

Applicant argues that the Claim 7 is statutory under 35 U.S.C 101.

Examiner disagrees.

A computer program product that comprising instructions which stores on computer readable media (computer readable media is intended to be software, see Page 6, Lines 25-31 of the specification and Page 6, Lines 27 points that the computer readable medium is "i.e., software"). Therefore, the “computer program product” does not appear to include or embody any functional hardware structure and is considered as program per se, which is not one of categories of statutory subject matter.

35 U.S.C 112(1)

Applicant argues that the specification does have written supports on the limitation:

“wherein the mobile system is configured to remain in the powered down state while the network adaptor is responding to the discovery of the stored requested by retrieving the requested asset information from nonvolatile storage..”

Examiner disagrees.

1) Various sections of the specification stating that it is the "mobile system", which responds to discovery of the stored request by retrieving the requested information:

“The mobile system responds to discovery of the stored request by retrieving the requested information from nonvolatile storage of the mobile system and transmitting the requested information via the wireless network adapter while otherwise remaining powered down. (Specification: Page 2, Lines 20- Page 3, Lines 2)”

“When the mobile system detects the stored asset information request, the mobile system retrieves the requested information, perhaps from an asset information storage device connected directly to the wireless NIC via a system management bus, and forwards the information to the AP. (Specification: Page 4, Lines 22- 25)”

"In either embodiment, this determination is made by inspecting the pending request field 412 of asset information table 330. If a mobile system 130 determines (block 520) that there is a pending request, mobile system 130 will respond by returning the requested information, the asset information, e.g., to the requesting server (Specification: Page 9, Lines 4-7)”

In matter of fact, the above cited section indicating that the mobile system must be powered up in order to response to the requested from AP by retrieving the asset information from the its memory.

2) According to the response on Page 11 and Page 12, applicant has submitted an admission that the following embodiment is conventional:

“In another embodiment, NIC 230 determines if there are any requests pending the next time it associates with AP 120 (e.g., when mobile system 130 is next powered on). In either

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embodiment, this determination is made by inspecting the pending request field 412 of asset information table 330. If a mobile system 130 determines (block 520) that there is a pending request, mobile system 130 will respond by returning the requested information, the asset information, e.g., to the requesting server.”

First, since applicant has admitted such embodiment is conventional, and such embodiment corresponds to Fig 5 of applicant’s specification, applicant should label Fig 5 as “Prior Art”

Second, the admission submitted supports the position that the specification does teach the mobile system has powered up during the steps of “responding to the request” (see Block 520 and Block 522), then the mobile system will return to the power off (see Block 522).

Therefore, the arguments are not persuasive and the rejection is therefore maintained.

35 U.S.C 112(2)

Applicant argues that Fig 2 contains clear supports that the only NIC is powered up to respond to asset information request while the mobile system otherwise remains powered down.

Examiner disagrees.

According to the Page 5, Lines 14-28 of specification that describing Fig 2. Nowhere explicitly describing that it is the NIC that retrieve the asset information from the flash 240 while the mobile system remains power down.

Applicant appears to relies on obviousness to supports the position that the limitation is not ambiguous (see Page 12 and 13 of the response), however, until applicant can provide the explicitly supports, the rejection is therefore maintained.

Affidavit

1. The affidavit filed on 07/16/09 under 37 CFR 1.131 has been considered but is ineffective to overcome the Fischer et al. reference.

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The declaration filed on 07/16/09 fails to provide evidence to support the indicated claim of conception prior to the effective date of the Fischer reference. The evidence is not enough to satisfy issues of diligence or conception reduction to practice or an actual reduction to practice.

2. Applicant is attempt to prove the invention by showing conception before September 10, 2003 (the effective data of Fischer) before that date until December 19, 2003, the date of filing of this application.

3. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Fischer reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Applicant has not yet support each of claim element with the affidavit to demonstrate conception. Applicant must point out where each claimed limitation is according to the affidavit on record.

4. Applicant has not demonstrated the reasonable diligence from the period of September 10, 2003, to December 22, 2003.

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2138.06 [R-1] "Reasonable Diligence"

The diligence of 35 U.S.C. 102(g) relates to rea-sonable "attorney-diligence" and "engineering-diligence" (*Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that "an inventor or his attorney ... drop all other work and concentrate on the particular invention involved...." *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974).

CRITICAL PERIOD FOR ESTABLISHING DILIGENCE BETWEEN ONE WHO WAS FIRST TO CONCEIVE BUT LATER TO REDUCE TO PRACTICE THE INVENTION

The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) ("lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts"). What serves as the entry date into the field of a first reducer is dependent upon what is being relied on by the first reducer, e.g., conception plus reasonable diligence to reduction to practice (*Fritsch v. Lin*, 21 USPQ2d 1731, 1734 (Bd. Pat. App. & Inter. 1991), *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974)); an actual reduction to practice or a constructive reduction to practice by the filing of either a U.S. application (*Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)) or reliance upon priority under 35 U.S.C. 119 of a foreign application (*Justus v. Appenzeller*, 177 USPQ 332, 339 (Bd. Pat. Inter. 1971) (chain of priorities under 35 U.S.C. 119 and 120, priority under 35 U.S.C. 119 denied for failure to supply certified copy of the foreign application during pendency of the application filed within the twelfth month)).

THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

An applicant must account for the entire period during which diligence is required. *Gould*

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v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent’s entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project);

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Tucker v. Natta, 171 USPQ 494, 498 (Bd. Pat. Inter. 1971) (“[a]ctivity directed toward the reduction to practice of a genus does not establish, *prima facie*, diligence toward the reduction to practice of a species embraced by said genus”); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. “[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....”).

**WORK RELIED UPON TO SHOW REASONABLE DILIGENCE MUST BE
DIRECTLY RELATED TO THE REDUCTION TO PRACTICE**

The work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. *Naber v. Cricchi*, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977), *cert. denied*, 439 U.S. 826 (1978). >See also *Scott v. Koyama*, 281 F.3d 1243, 1248-49, 61 USPQ2d 1856, 1859 (Fed. Cir. 2002) (Activities directed at building a plant to practice the claimed process of producing tetrafluoroethane on a large scale constituted efforts toward actual reduction to practice, and thus were evidence of diligence. The court distinguished cases where diligence was not found because inventors either discontinued development or failed to complete the invention while pursuing financing or other commercial activity.); *In re Jolley*, 308 F.3d 1317, 1326-27, 64 USPQ2d 1901, 1908-09 (Fed. Cir. 2002) (diligence found based on research and procurement activities related to the subject matter of the interference

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count).< “[U]nder some circumstances an inventor should also be able to rely on work on closely related inventions as support for diligence toward the reduction to practice on an invention in issue.” *Ginos v. Nedelec*, 220 USPQ 831, 836 (Bd. Pat. Inter. 1983) (work on other closely related compounds that were considered to be part of the same invention and which were included as part of a grandparent application). “The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter.” *Gunn v. Bosch*, 181 USPQ 758, 761 (Bd. Pat. Inter. 1973) (An actual reduction to practice of the invention at issue which occurred when the inventor was working on a different invention “was fortuitous, and not the result of a continuous intent or effort to reduce to practice the invention here in issue. Such fortuitousness is inconsistent with the exercise of diligence toward reduction to practice of that invention.” 181 USPQ at 761. Furthermore, evidence drawn towards work on improvement of samples or specimens generally already in use at the time of conception that are but one element of the oscillator circuit of the count does not show diligence towards the construction and testing of the overall combination.); *Broos v. Barton*, 142 F.2d 690, 691, 61 USPQ 447, 448 (CCPA 1944) (preparation of application in U.S. for foreign filing constitutes diligence); *De Solms v. Schoenwald*, 15 USPQ2d 1507 (Bd. Pat. App. & Inter. 1990) (principles of diligence must be given to inventor’s circumstances including skill and time; requirement of corroboration applies only to testimony of inventor); *Huelster v. Reiter*, 168 F.2d 542, 78 USPQ 82 (CCPA 1948) (if inventor was not able to make an actual reduction to practice of the invention, he must also show why he was not able to constructively reduce the invention to practice by the filing of an application).

DILIGENCE REQUIRED IN PREPARING AND FILING PATENT APPLICATION

The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. Conception is less a matter of signature than it is one of disclosure. Attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. Six days to execute and file application is acceptable. *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). Form paragraph 7.62 (reproduced in MPEP § 715) may be used to respond to a 37 CFR 1.131 affidavit where diligence is lacking.

5. The evidence submitted is insufficient to establish diligence from a date of conception to an actual reduction to practice. There is no information provided in the exhibits explicitly demonstrate diligence applied to reduce the method to practice.
6. The included Declaration fails to properly describe the events/dates between alleged conception (prior to September 10, 2003) and indicated Actual Reduction to Practice (December 19, 2003). Applicant's affidavits had not demonstrated during the critical period of September 10, 2003 and December 19, 2003 that discuss/show the element of claiming invention.

Specification

Claim 7-13 are objected to because according to MPEP 608.01, antecedent basis for the terms appearing in the claims, while an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. Applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced. The term “Computer Readable Storage Medium” lacks clear support or antecedent basis in the description of the specification. Please also see 37 CFR 1.75 (d)(1).

Drawings

Figure 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

According to the response on Page 11 and Page 12, applicant has submitted an admission that the following embodiment is conventional:

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“In another embodiment, NIC 230 determines if there are any requests pending the next time it associates with AP 120 (e.g., when mobile system 130 is next powered on). In either embodiment, this determination is made by inspecting the pending request field 412 of asset information table 330. If a mobile system 130 determines (block 520) that there is a pending request, mobile system 130 will respond by returning the requested information, the asset information, e.g., to the requesting server.”

First, since applicant has admitted such embodiment is conventional, and such embodiment corresponds to Fig 5 of applicant's specification, applicant should label Fig 5 as “Prior Art”

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-8, and 10-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 is rejected because there is no written support within the specification supporting “the mobile system otherwise remains in the power down state while the wireless network adaptor responds to the discovery of the stored request”

1) Various sections of the specification stating that it is the "mobile system", which responds to discovery of the stored request by retrieving the requested information:

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“The mobile system responds to discovery of the stored request by retrieving the requested information from nonvolatile storage of the mobile system and transmitting the requested information via the wireless network adapter while otherwise remaining powered down. (Specification: Page 2, Lines 20- Page 3, Lines 2)”

“When the mobile system detects the stored asset information request, the mobile system retrieves the requested information, perhaps from an asset information storage device connected directly to the wireless NIC via a system management bus, and forwards the information to the AP. (Specification: Page 4, Lines 22- 25)”

“In either embodiment, this determination is made by inspecting the pending request field 412 of asset information table 330. If a mobile system 130 determines (block 520) that there is a pending request, mobile system 130 will respond by returning the requested information, the asset information, e.g., to the requesting server (Specification: Page 9, Lines 4-7)”

In matter of fact, the above cited section indicating that the mobile system must be powered up in order to response to the requested from AP by retrieving the asset information from the its memory.

2) According to the response on Page 11 and Page 12, applicant has submitted an admission that the following embodiment is conventional:

“In another embodiment, NIC 230 determines if there are any requests pending the next time it associates with AP 120 (e.g., when mobile system 130 is next powered on). In either embodiment, this determination is made by inspecting the pending request field 412 of asset information table 330. If a mobile system 130 determines (block 520) that there is a pending request, mobile system 130 will respond by returning the requested information, the asset information, e.g., to the requesting server.”

First, since applicant has admitted such embodiment is conventional, and such embodiment is corresponds to Fig 5 of applicant’s specification, applicant should label Fig 5 as “Prior Art”

Second, the admission submitted supports the position that the specification does teaches the mobile system has powered up during the steps of “responding to the request” (see Block 520 and Block 522), then the mobile system will return to the power off (see Block 522).

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is ambiguous and contradicting for applicant to claimed it is the “wireless network adaptor” that is configured to respond to discovery of the stored request by retrieving the request information while applicant's own specification (i.e., see abstract, page 9, Lines 5-9) has indicates that it is the mobile device/system that is performing the act of responds (e.g., mobile system response to discovery of the stored request by retrieving the requested information from nonvolatile storage of the mobile system and transmitting the requested information via the wireless network adaptor to the access point and subsequently returned to the powered down state,

Due to the contradiction by the specification and abstracts, for the examining purposes, the is reasonable to interprets that it is the "mobile system" that “response to discovery of the stored request by retrieving the requested information from nonvolatile storage of the mobile system and transmitting the requested information via the wireless network adaptor to the access point and subsequently returned to the powered down state.”

Correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7, 8, 10-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A computer program product that comprising instructions which stores on computer readable media (computer readable media is intended to be software, see Page 6, Lines 25-31 of the specification and Page 6, Lines 27 points that the computer readable medium is "i.e., software"). Therefore, the "computer program product" does not appear to include or embody any functional hardware structure and is considered as program per se, which is not one of categories of statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-10, 14, and 19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (US 7,324,468) in view of Linskog et al hereinafter Linskog 626' (US 2001/0031626) in further view of Linskog et al hereinafter Linskog 603' (US 2002/0132603).

1. Referring to Claims 1 and 3, Fischer discloses a data processing network configuration comprising:

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an access point configured to receive and store a request to retrieve information from a mobile system associated with the access point (refer to Col 5, Lines 58-67);

a mobile system having a wireless network adapter, and the mobile system being configured to periodically wake from a powered down state (refer to Col 11, Lines 37-46, Col 6, Lines 25-28);

wherein the mobile system otherwise remains in the powered down state while the wireless network adaptor responds to the discovery of the stored request (mobile system response to the discovery of the stored request, since the system is awake and the wireless network adaptor is a part of system, must be obvious for the wireless network adaptor to response to the request since the wireless network adaptor and the mobile system is being interpreted as a same entity, Col 12, Lines 55-65 and Col 13, Lines 1-11);

wherein the wireless network adapter configured to respond to discovery of the stored request by retrieving the requested information from the nonvolatile storage of the mobile system (Col 12, Lines 55-65 and Col 13, Lines 1-11) and transmitted the requested information via the wireless network adaptor to the access point and subsequently returned to the powered down state in response to the transmitting the requested information (refer to Col 12, Lines 40-50);

Although Fischer disclosed the invention substantially as claimed, Fischer did not explicitly disclosing "poll the access point to discover the stored request for asset information on the access point"

Lindskog 626', in analogous art disclosing "poll the access point to discover the stored request for asset information on the access point (refer to par 0017 and par 0021 and par 0037)"

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Fischer and Linskog 626' because Linskog 626' teaching of "poll the access point to discover the stored request for asset information on the access point" would improve Fischer's system efficiency by obtaining the real-time detection of needs.

Although Fischer and Linskog 626' disclosed the invention substantially, Fischer and Linskog 626' did not explicitly disclosing that "the wireless adaptor wakes from the powered down state and a storage unit connected directly to the wireless network adaptor"

Linskog 603', in analogous art, disclosing "the wireless adaptor wakes from the powered down state (refer to par 0057) and a storage unit connected directly to the wireless network adaptor via two wire serial bus (must be an internal storage that is directly attached to NIC in order to transmit/receive information, refer to par 0052)"

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Fischer, Linskog 626', Linskog 603' because Linskog 603's teaching of "the wireless adaptor wakes from the powered down state and a storage unit connected directly to the wireless network adaptor" would improve Fischer's system efficiency by establish higher power saving state within the mobile system.

2. Referring to Claim 4, Fischer, Linskog 626', Linskog 603' disclosed the network of claims 1.

Fischer further disclosing that wherein the access point is configured to store the pending request in a table having an entry for each mobile system associated with the access point wherein each

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entry in the request contains address of the corresponding mobile system's wireless network adaptor (refer to Col 7, Lines 30-43).

3. Referring to Claim 5, Fischer, Linskog 626', Linskog 603' disclosed the network of claim 1.

Fischer further disclosing that wherein the access point store the pending request in a table having an entry for each mobile system associated with the access point wherein each entry in the request contains address of the corresponding mobile system's wireless network adaptor (refer to Col 7, Lines 30-43), wherein asset information from the mobile system is stored in the allocated entry associated with the mobile system (refer to Col 5, Lines 57-65).

4. Referring to Claim 6, Fischer, Linskog 626', Linskog 603' disclosed the network of claim 1.

Linskog 626' further disclosing that wherein the access point is to store asset information of the mobile system in the table of the access point (refer to par 0017 and par 0021 and par 0037)"

5. Referring to Claims 7-10, 14, 19 and 21, the claims are rejected with similar rational as Claims 1, 3-6.

Claims 2, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (US 7,324,468) in view of Linskog et al hereinafter Linskog 626' (US 2001/0031626)

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in further view of Lingskog et al hereinafter Lingskog 603' (US 2002/0132603) in further view of Cheshire (US 2007/0038877) .

6. Referring to Claims 2, Fischer, Lingskog 626' and Lingskog 603' disclosed the network of claim 1. Although Fischer, Lingskog 626', and Lingskog 603' disclosed the invention substantially as claimed, Fischer, Lingskog 626', and Lingskog 603' did not explicitly stating "wherein the access point is configured to recognize the request as a packet containing a media access control (MAC) address repeated multiple times and an appended control field."

Cheshire, in analogous art, disclosing, "wherein the access point is configured to recognize the request as a packet containing a media access control (MAC) address repeated multiple times and an appended control field. (refer to par 0005 and 0009)"

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Fischer, Lingskog 626', Lingskog 603' and Cheshire because Cheshires teaching of "wherein the access point is configured to recognize the request as a packet containing a media access control (MAC) address repeated multiple times and an appended control field " would improve Fischer's system efficiency by allowing server to access information without perform various medium access activities (see Fischer, Col 14, Lines 13-25).

7. Referring to Claims 13, 15, and 16, the claims are rejection with similar rational as Claim 2.

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Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (US 7,324,468) in view of Lindskog et al hereinafter Lingskog 626' (US 2001/0031626) in further view of Lingskog et al hereinafter Lingskog 603' (US 2002/0132603) in further view of Cromer et al hereinafter Cromer (US 6,381,636)

8. Referring to Claim 11, Fischer and Hitt disclosed the computer program product of claim 10.

Although Fischer, Lindskog 626', Lingskog 603' disclosed the invention substantially as claimed, Fischer, Lindskog 626', and Lingskog 603' did not explicitly disclosing "wherein each table entry contains a MAC address of the corresponding wireless network adapter."

Cromer, in an analogous disclosing "wherein entry contains a MAC address of the corresponding wireless network adapter (refer to Col 6, Lines 29-43);"

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Although Fischer, Lindskog 626', Lingskog 603' and Cromer because Cromer's teaching of "wherein each table entry contains a MAC address of the corresponding wireless network adapter " would improve Fischer's system efficiency by allowing server to access information without perform various medium access activities (see Fischer, Col 14, Lines 13-25).

9. Referring to Claim 12, Although Fischer, Lindskog 626', Lingskog 603' and Cromer disclosed the computer program product of claim 11.

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Lingskog 626' further discloses wherein the mobile system stores its asset information in the table and computer readable storage medium containing code which configures the access point to store the asset information further contains code to configure the access point to, responsive to a subsequent request for the mobile system's asset information, service the request using asset information stored at the access point (refer to par 0017 and par 0021 and par 0037);

Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (US 7,324,468) in view of Lingskog et al hereinafter Lingskog 626' (US 2001/0031626) in further view of Lingskog et al hereinafter Lingskog 603' (US 2002/0132603), Cheshire (US 2007/0038877) and Cromer et al hereinafter Cromer (US 6,381,636)

10. Referring to Claim 17. Fischer, Hitt and WOL disclosed the service method of Claim 16.

Although Fischer, Lingskog 626' Lingskog 603, and Cheshire discloses the invention substantially as claimed. Fischer, Lingskog 626' Lingskog 603, and Cheshire did not expressly disclose "wherein the mobile system contains a Management Information Format (MIF) information"

Cromer, in an analogous art, disclosing "wherein the mobile system contains a Management Information Format (MIF) information (refer to Col 1, Lines 63-67)."

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Fischer, Lingskog 626' Lingskog 603, Cheshire and Cromer because Cromer's teaching of "wherein each entry in the table is further enabled to store the corresponding mobile system's MIF asset information" would improve Fischer's system

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efficiency by allowing server to access information without perform various medium access activities (see Fischer, Col 14, Lines 13-25).

11. Referring to Claim 18. Fischer, Lingskog 626' Lingskog 603, Cheshire and Cromer disclosed the service method of Claim 17. Although Fischer, Hitt, and WOL discloses the invention substantially as claimed.

Lingskog 626' disclosed the request information is the asset information (refer to par 0017 and par 0021 and par 0037)

Cheshire disclosed " wherein the server request is a request for the mobile client's information and wherein the access point services the request itself if the table contains a valid copy of the mobile client's information (refer to par 0009)"

Conclusion

Examiner's Notes: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the

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specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-Thr 8 - 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Karen C Tang/
Primary Examiner, Art Unit 2451